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EXAMINER

CARTER, KENDRA D

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/007,869	<b>Applicant(s)</b> GRANGER ET AL.	
	<b>Examiner</b> KENDRA D. CARTER	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7,9-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-12 and 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 23, 2008 has been entered.

The Examiner acknowledges the applicant's remarks and arguments of October 29, 2008 made to the office action filed May 29, 2008. Claims 1, 2, 4-7, 9-12 and 14-24 are pending. Claims 22-24 are new.

In light of the new claims the previous rejections are withdrawn. The withdrawn rejections include the following: 1) the 35 U.S.C. 103(a) rejection of claims 1-2, 4-7, 9-12, 14-15 and 17 as being unpatentable over Soares et al. in view of Nakatsu et al., and further in view of Liu et al.; 2) the 35 U.S.C. 103(a) rejection of claim 18 as being unpatentable over Soares et al., in view of Nakatsu et al., and further in view of Liu et al. as applied to claims 1-2, 4-7, 9-12, 14-15 and 17 above, and further in view of Kobayashi et al. 3) the 35 U.S.C. 103(a) rejection of claim 16 as being unpatentable

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over Suares et al., in view of Nakatsu et al., and further in view of Liu et al. as applied to claims 1-2, 4-7, 9-12, 14-15 and 17 above, and further in view of Kobayashi et al, and Pillai et al.

Due to the amendment to the claims, the new 35 U.S.C. 103(a) rejections are made below. The Applicant's arguments are addressed below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**(1) Claims 1-2, 4-7, 9-12, 14, 15, 17 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suares et al (U.S. Patent No. 5,914,116), in view**

**Nakatsu et al (U.S Patent No. 5,965,518), and further in view of Liu et al. (U.S. Patent No. 5,976,555) and Blank et al. (US 5,605,894).**

Suares et al. teaches a method for a skin treatment regime and product that includes a first composition containing at least one active and functioning to impart a first benefit to skin, and a second composition that includes a second different active and imparts a second benefit to skin (see abstract, in particular.) Suares et al. teaches that the first and second compositions are stored in respective separate containers, which are joined together (see abstract and column 2, lines 1-14, in particular.) Suares et al. teaches that the two compositions are kept separate because single formulations often compromise the performance of the severally combined actives (i.e. dual compartment package; see column 1, lines 15-25, in particular.) Thus, Suares et al. teaches providing a first composition in a first compartment, and a second composition in a second compartment, where the compositions in each respective containers are isolated from one another, and where the first and second compartments are joined together, as recited in claim 1.

With regards to the types of compositions provided, Suares et al. provides examples of first compositions and second compositions where the first composition is a cleanser and the second composition is an anti-acne preparation (see Table I, second entry, in particular), and also where the first composition is a sunscreen and the second composition is an anti-wrinkle cream (see Table I, tenth entry, in particular.) Suares et

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al. teaches that anti-wrinkle compositions and anti-acne preparations can contain actives such as retinoids, where suitable retinoids include retinol, retinoic acid or C<sub>1</sub>-C<sub>20</sub> esters of retinol and retinoic acid (see column 4, lines 20-25 and 59-65 and column 5, lines 12-16, in particular.) Soares et al. teaches levels of retinoids in the compositions may be from 0.00001 to 2% (see column 4, lines 60-65, in particular), which is an amount that overlaps with that recited in claim 1. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the retinoid provided in the anti-acne or anti-wrinkle composition, according to the guidance provided by Soares et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.) Soares et al. also exemplifies a sunscreen composition suitable for the two-composition product having a fragrance (see column 8, Table II, in particular.)

Accordingly, Soares et al. teaches providing an anti-wrinkle or anti-acne composition corresponding to the first composition as recited in claim 1, and teaches providing the first composition and a second composition (such as a sunscreen or cleanser composition) in first and second compartments isolate the compositions and that are also joined, as recited in claim 1.

Suares et al. does not specifically teach a second composition comprising the specific retinoid booster, such as citral, citronella, etc, as recited in claim 1. Suares et al. also does not specifically teach that the compartment having the retinoid keeps the retinoid composition out of contact with oxygen, as recited in claim 1. Lastly, Suares et al. does not specifically teach wherein from about 1 to about 5 ml of the first composition and second composition are used (claims 21-24).

Blank et al. teach a composition for regulating wrinkles and/or atrophy in mammalian skin comprising treating the skin with a safe and effective amount of active components (see abstract). Sunscreens such as 8-hydroxyquinoline salts may be used (see column 4, lines 28-29). The preferred wrinkle and atrophy regulating composition comprises a retinoid such as retinol-like compounds (see column 7, lines 25-35). The amount of suncreening agent applied is generally from about 0.02mg to about 1.0 mg per cm<sup>2</sup> skin (see column 13, lines 1-2). The amount of the retinoid applied is generally from about 0.00001 mg to about 0.02 per cm<sup>2</sup> skin (see column 13, lines 12-13). Use of an amount of the composition to deposit about 2 mg/cm<sub>2</sub> of the active compound to the skin is appropriate (see column 14, lines 5-9). The amount of actives and frequency of topical application to the skin can vary widely, depending upon personal needs (see column 12, lines 34-55).

Nakatsu et al. teaches a fragrance composition that can include non-aromatic terpenoid compounds such as citral, citronellol, geraniol and linalool, and that is suitable

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for various products (see abstract, and column 3, lines 25-45, in particular), and thus teaches the retinoid boosters as recited in claim 1. Nakatsu et al. teaches that the fragrance composition can be included in a skin cream, hand and body lotion, sunscreen, and other compositions (see claim 9, in particular.) Thus, Nakatsu et al. teaches fragrances and fragrance compositions that are suitable for topical application to skin and can be used in topical formulations such as sunscreens.

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide from about 1 to about 5 mL of the first composition and second composition when used (claims 22-24) in the compositions of Soares et al. because of the following teachings: 1) Blank et al. teach a composition for regulating wrinkles and/or atrophy in mammalian skin comprising treating the skin with a safe and effective amount of active components (see abstract), wherein the amount of the active agents applied is determined by the amount of skin being covered (see column 14, lines 5-9) and 2) Blank et al. also teach that the amount of actives and frequency of topical application to the skin can vary widely, depending upon personal needs (see column 12, lines 34-55). Thus, the amount of the composition used would be obvious depending on the amount of skin that the composition is applied, the concentration of the composition and the desired need of results for treating wrinkles or/and sun protection.



Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the fragrances and fragrance compositions of Nakatsu et al. in the compositions of Soares et al, and in particular in the sunscreen composition of Soares et al., because Soares et al. exemplifies such sunscreens have fragrances, and Nakatsu et al. teaches fragrances that are suitable for topical compositions such as sunscreens. Thus, one of ordinary skill in the art would have been motivated to provide the fragrances in the composition of Soares et al. with the expectation of providing a fragrance that is suitable for topical use and that is known to be suitable for combination with sunscreen compositions.

Regarding the amount of the fragrances provided, as recited in claim 1, it is noted that Nakatsu et al. teaches that the fragrance composition itself can comprise between 20 and 80% non-aromatic terpenoids, such as those claimed (see abstract, in particular), and Soares et al. exemplifies a composition having 0.30% of a fragrance (see Table II, in particular), which is an amount that meets the limitation of the claim. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the fragrance provided in the composition, according to the guidance provided by Nakatsu et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Accordingly, the teachings of Soares et al. and Nakatsu et al. render obvious a skin care product comprising first and second compartments for storing compositions, the compartments being joined, where the product comprises an anti-wrinkle cream having the retinoid first composition as claimed, and a sunscreen having the retinoid booster second composition (i.e. comprising fragrances), as recited in claim 1.

The combination of Soares et al. and Nakatsu et al. does not teach providing a compartment that keeps the retinoid composition out of contact with oxygen as recited in claim 1, such as a compartment made out of aluminum.

Liu et al. teaches that it is known that retinoids such as retinol, retinal and retinyl esters quickly lose their activity and oxidize in conventional skin care products (see column 2, lines 35-55, in particular). Liu et al. teaches that the oxidation of skin care compositions can be reduced by excluding oxygen permeation, particularly by fabricating the container walls from aluminum (see column 12, lines 40-68, in particular), and thus teaches providing an aluminum container that keeps the retinoid composition out of contact with oxygen, as recited in claim 1, and thus also provides a "stable" skin care product.

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to modify the two compartment

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product teachings of Soares et al. to provide a compartment made of aluminum for the retinoid composition that keeps the retinoid out of contact with oxygen, because Soares et al. teaches the desirability of providing the two-compartment product to maximize the effectiveness of the separate compositions, and teaches providing retinoids in one of the compositions, while Liu et al. teaches that it is known that retinoids such as those taught by Suarez et al. can easily oxidize and lose their effectiveness, and that such oxidation can be reduced by providing aluminum containers. Thus, it is considered that one of ordinary skill in the art would have been motivated to provide the aluminum compartment to store the retinoid composition in the product of Soares et al, with the expectation of improving the effectiveness of the retinoid composition. Accordingly, claim 1 is obvious over the teachings of Soares et al. in view of Nakatsu et al. and further in view of Liu et al.

Regarding the recitation in claim 1 of "the first composition not being chemically degraded by the second composition and not coming into contact with the second compositions when being stored in the first compartment," it is noted, as discussed above, that Soares et al. teaches the two compositions in the different compartments are kept separate because single formulations often compromise the performance of the severally combined actives (see column 1, lines 15-25, in particular.) Thus, it is considered that Soares et al. teaches that the compositions are isolated in each compartment so that the actives in each composition will not compromise the performance of one another, and thus teaches compartments in which the compositions

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are not degraded by each other and do not come in contact when being stored, as recited in claim 1.

Furthermore, regarding the recitations that “the first composition not being chemically degraded by the second composition and not coming into contact with the second compositions when being stored in the first compartment,” and “the second composition potentiates the action of the retinoid upon contact,” it is noted that as combined teachings of Soares et al, Nakatsu et al. and Liu et al. renders the claimed product and compositions obvious, the property of such a claimed product/compositions will also be rendered obvious by the prior art teachings, since the properties, namely the avoidance of degradation, lack of contact, and potentiation of action on contact, are inseparable from its composition. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly claimed product.

Regarding the recitation that the components of the second composition act are “retinoid boosters”, as recited in the claims, it is noted that the retinoid boosting activity of a compound is a property thereof, and a product and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Accordingly, the

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composition rendered obvious by the combined references would, absent evidence to the contrary, meet the limitations pertaining to the retinoid boosting activity of the compound used therein.

Regarding claims 6 and 11, Soares et al, Nakatsu et al. and Liu et al. render obvious a product having first and second compartment that are joined together, and that isolate the compositions therein, the first composition keeping out oxygen and being made of aluminum, with a first composition having a retinoid as recited in the claims, and a second composition having a fragrance corresponding to the retinoid boosters as recited in the claims, as has been discussed above. While the references do not specifically teach providing the amount ranges of retinoid and retinoid booster as recited in the claims, the references do teach providing amounts that are close to and/or overlap with the amounts as recited. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of retinoids and/or fragrances provided in the composition, according to the guidance provided by Soares et al., Nakatsu et al and Liu et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 2, 7 and 12, it is noted that Nakatsu et al. teaches the fragrances citral, citronellol and linalool, among others, may be provided in the composition, while the teachings of Soares et al. and Nakatsu et al. render obvious providing a fragrance composition in the amount as claimed, and thus the references teach that at least two fragrances (retinoid boosters) may be provided, as recited in the claims.

Regarding the methods of claims 4-5, 9-10 and 14-15, Soares et al. teaches that the retinoid may be a part of an anti-acne composition, and also acts as an anti-wrinkle agent (see column 4-5, in particular), and thus teaches providing the composition on skin for the treatment of acne and wrinkles. Soares et al. also teaches that the compositions can comprise emollients and humectants (see column 5, lines 35-40, in particular), which moisturize and condition the skin. Furthermore, as the combined teachings of Soares et al, Nakatsu et al. and Liu et al. renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the conditioning of skin upon application, or the mimicking of the effect of retinoic acid such as the treatment of acne or wrinkles, upon application to skin, are inseparable from its composition. Therefore, if the prior art teaches the composition or renders the composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess or render

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obvious the same properties as the instantly claimed product. Thus, the methods as taught by Soares et al, Nakatsu et al. and Liu et al. necessarily result in skin conditioning, treatment of acne, wrinkles, etc, as recited in the claims.

Regarding claim 17, Soares et al. teaches that the composition can comprise an emollient such as esters of fatty acids and fatty acids (see column 5 line 35 through column 6, line 60, in particular), and thus teaches the emollients as claimed. Regarding the amounts of the emollients, Soares et al. teaches that the emollients can be provided as a part of the carrier, which can be in an amount of from 30 to 99.9% (see column 5, lines 35-42, in particular.) Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of emollient provided in the composition, according to the guidance provided by Soares et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 19-21, wherein the first composition and second composition are utilized simultaneously is considered a use of the composition and does not get patentable weight in composition claims. The teachings of Soares et al. in view of Nakatsu et al. and Liu et al. obviously teach the claimed composition, thus the use is not given patentable weight.

**(2) Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suares et al (U.S. Patent No. 5,914,116), in view Nakatsu et al (U.S Patent No. 5,965,518), and further in view of Liu et al. (U.S. Patent No. 5,976,555) and Blank et al. (US 5,605,894), as applied to claims 1-2, 4-7, 9-12, 14, 15, 17 and 19-24 above, and further in view of Kobayashi et al (JP 04183797).**

Suares et al, Nakatsu et al., Liu et al, and Blank et al., are applied as discussed for claims 1-2, 4-7, 9-12, 14-5 and 17 above, and render obvious the product having first and second compartment that are joined together and that isolate the compositions therein, the first composition keeping out oxygen, with a first composition having a retinoid as recited in the claims, and a second composition having a fragrance corresponding to the retinoid boosters as recited in the claims. Specifically, Suares et al, Nakatsu et al. and Liu et al. render obvious a product with anti-wrinkle composition having the retinoid, and a sunscreen composition having the fragrances (retinoid boosters), as recited in the claims.

The references do not specifically teach providing a retinoid booster that is alpha-ionone, as recited in claim 18.

Kobayashi et al. teaches compositions for formulation into cosmetics containing perfumes (see abstract, in particular.) Kobayashi et al. teaches that suitable perfumes



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for incorporation into cosmetics include ionone (alpha-ionone) (see Constitution section, in particular.)

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the ionone fragrance of Kobayashi et al. in the compositions of Soares et al, Nakatsu et al, and Liu et al, and in particular in the sunscreen composition of Soares et al, Nakatsu et al, and Liu et al, because Soares et al, Nakatsu et al, and Liu et al. teach such sunscreens having fragrances, and Kobayashi et al. teaches that ionone is a fragrance that is suitable for cosmetic formulations. Thus, one of ordinary skill in the art would have been motivated to provide the fragrances in the composition of Soares et al, Nakatsu et al, and Liu et al. with the expectation of providing a fragrance in the composition that is suitable for cosmetic use.

**(3) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soares et al (U.S. Patent No. 5,914,116), in view Nakatsu et al (U.S Patent No. 5,965,518), and further in view of Liu et al. (U.S. Patent No. 5,976,555) and Blank et al. (US 5,605,894), as applied to claims 1-2, 4-7, 9-12, 14, 15, 17 and 19-24 above, and further in view of Kobayashi et al (JP 04183797), and Pillai et al (U.S. Patent No. 5,582,832).**

Suares et al, Nakatsu et al., Liu et al, and Blank et al. are applied as discussed for claims 1-2, 4-7, 9-12, 14-5 and 17 above, and render obvious a product having first and second compartment that are joined together and that isolate the compositions therein, the first compartment keeping out oxygen, with a first composition having a retinoid as recited in the claims, and a second composition having a fragrance corresponding to the retinoid boosters as recited in the claims. Specifically, Suares et al, Nakatsu et al. and Liu et al. render obvious a product with anti-wrinkle composition having the retinoid, and a sunscreen composition having the fragrances (retinoid boosters), as recited in the claims.

The references do not specifically teach providing a retinoid booster that is climbazole in combination with a second retinoid booster selected from the groups consisting of alpha-ionone and damascenone, as recited in claim 16.

The teachings of Kobayashi et al. have been discussed for claim 18 above, and teach providing ionone as a fragrance in cosmetic compositions. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the ionone fragrance of Kobayashi et al. in the compositions of Suares et al, Nakatsu et al, and Liu et al, and in particular in the sunscreen composition of Suares et al, Nakatsu et al, and Liu et al, because Suares et al, Nakatsu et al, and Liu et al. teach such sunscreens having fragrances, and Kobayashi et al. teaches that ionone is a fragrance that is suitable for cosmetic

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formulations. Thus, one of ordinary skill in the art would have been motivated to provide the fragrances in the composition of Soares et al, Nakatsu et al, and Liu et al. with the expectation of providing a fragrance in the composition that is suitable for cosmetic use.

Soares et al, Nakatsu et al, Liu et al. and Kobayashi et al. do not specifically teach providing climbazole in the composition, as recited in claim 16.

Pillai et al. teaches compositions for treating skin that contain an azole ingredient (see abstract, in particular.) Pillai et al. teaches that suitable azoles include climbazole (see column 4, lines 1-21, in particular), and further teaches that the azoles can be formulated into compositions including sunscreen compositions (see column 11, lines 34-55, in particular.) Pillai et al. even exemplifies a sun cream formulation comprising an azole (see Example 8, in particular.)

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the climbazole of Pillai et al. in the composition of Soares et al, Nakatsu et al, Liu et al. and Kobayashi et al, because Soares et al, Nakatsu et al, Liu et al. and Kobayashi et al. teach a product having a topical sunscreen formulation, and Pillai et al. teaches that azole compositions having azoles such as climbazole can be formulation into sunscreens. Thus, one of ordinary skill would have been motivated to provide the climbazole in the sunscreen composition

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of Soares et al, Nakatsu et al, Liu et al, and Kobayashi et al, with the expectation of providing a suitable ingredient for the sunscreen formulation.

### ***Response to Arguments***

#### **35 U.S.C. 103(a) rejections**

Applicant's arguments regarding the rejections of the claims have been fully considered but they are not persuasive.

The Applicant argues that the Examiner has admitted that the combination of the teachings of the '116 reference and the '518 reference does not render the claimed invention obvious since it does not describe providing a compartment that keeps retinoid containing compositions out of contact with oxygen. Contrary to the presently claimed invention, nothing in the '116 reference even remotely suggests a stable skin care product that has two compositions that are isolated from each other in different compartment prior to use wherein the first composition is also kept out of contact with oxygen, or that two compositions boosts the performance of the other. New claims 22-24 further define the claimed invention in that the first and second composition are used in particular amounts/combinations.

The Examiner respectfully disagrees, and notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner has clearly pointed out what '116 and '518 do not teach, but does not state

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that the references do not render the claimed invention obvious. The references '116 and '518 render the claimed invention obvious in combination with '555. Particularly, '116 teaches a stable skin care product that has two compositions that are isolated from each other in different compartments prior to use in the abstract and column 2; lines 1-14. More particularly, '116 teaches that the two compositions are kept separate because single formulation often compromise the performance of the severally combined actives (see abstract and column 2; lines 1-14).

In regards to the first composition being kept out of contact with oxygen, one of ordinary skill in the art at the time the invention was made would have found it obvious to modify the two compartment product teachings of Soares et al., because of the following teachings: 1) Soares et al. teach the desirability of providing the two-compartment product to maximize the effectiveness of the separate compositions, and teaches providing retinoids in one of the compositions; and 2) Liu et al. teaches that it is known that retinoids such as those taught by Suarez et al. can easily oxidize and lose their effectiveness, and that such oxidation can be reduced by providing aluminum containers. Thus, it is considered that one of ordinary skill in the art would have been motivated to provide the aluminum compartment to store and keep out oxygen with the expectation of improving the effectiveness of the retinoid composition.

In regards to the property exhibited when the second composition comes in contact with the first composition, these properties are inherently taught by the

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combined teachings of '116 and '518. The reference '116 teaches that the first composition can be a sunscreen and the second composition is an anti-wrinkle cream (see Table 1, tenth entry). The anti-wrinkle compositions contain retinoids active ingredients such as retinol, retinoic acid or C<sub>1</sub>-C<sub>20</sub> esters of retinol and retinoic acid (see column 4, lines 20-25 and 59-65 and column 5, lines 12-16). Lastly, '116 teaches that the sunscreen composition has fragrances (see column 8, Table II). The reference '518 provides the teaching that common fragrances that are used in various products such as skin cream, hand and body lotion, sunscreen and other compositions include citral, citronellol, geraniol and linalool (see abstract; column 3, lines 25-45; and claim 9). Thus, the combined references teach the applicant's compositions. Upon the same two compositions coming in contact with one another, they will inherently have the same reaction. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. Thus, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). "Products of identical chemical composition can not have mutually exclusive properties." Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In *re Spada*, 911 F. 2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly

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claimed product. Additionally, the reference '116 teaches that the two compositions are separated because single formulations often compromise the performance of the severally combined actives (see abstract and column 2; lines 1-14). Thus, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Regarding claims 19-21, wherein the first composition and second composition are utilized simultaneously is considered a use of the composition and does not get patentable weight in composition claims. The teachings of Soares et al. in view of Nakatsu et al. and Liu et al. obviously teach the claimed composition, thus the use is not given patentable weight.

The Applicant argues that the deficiencies of the references relied on by the Examiner are not cured by the '797 reference the '832 reference.

The Examiner disagrees for the reasons above and because the '797 reference provides the teaching of the particular fragrance ionone which can also be used in cosmetics. Since the composition of '115 is also a cosmetic, one skilled in the art would find it obvious to use the fragrance of '797 because the fragrance has been shown to be

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used in other topical skin cosmetic compositions. The same argument applies to the '832 reference. More particularly, '832 provides teachings of a fragrance used in a sunscreen. Thus, one skilled in the art would find it obvious to use the fragrance of '832 because the fragrance has been shown to be used in other sunscreen compositions.

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### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENDRA D. CARTER whose telephone number is (571)272-9034. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**Deleted:** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). ¶  
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. ¶

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/K. D. C./

Examiner, Art Unit 1617

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617